

## **REMARKS**

In the final Office action mailed May 5, 2005, the examiner rejects claims 1-16 and does not consider claim 17. This reply does not amend the claims. Thus, claims 1-17 remain pending and under consideration.

### **I. Request for entry**

The applicants request entry of this reply under Rule 116 because this reply does not alter the scope of the claims.

### **II. Failure to consider claim 17**

The reply filed September 12, 2005, added claim 17. The Office action fails to consider the patentability of claim 17 over the prior art. As such, the action is incomplete, and the applicants respectfully request the examiner to examine claim 17 and issue an action containing the examiner's findings.

37 C.F.R. 1.113 requires that a final action clearly state the grounds of rejection for all claims. Since no grounds have been provided, the rejection is not properly final. Withdrawal of the finality is also requested.

### **III. Rejection based on "abstract mediating request"**

Since the filing of the application, claim 4 has contained the term "abstract mediating request". As such, the examiner has now had three opportunities to consider the patentability of this term.

In the action, the examiner rejects claims 1, 12, 13, and 17 under section 112, second paragraph on the ground that "the term abstract mediating request is arbitrary". The examiner's actions raise several issues.

First, the examiner does not reject claim 4 under 112 although it contains the exact same term. As such, the examiner seems to indicate that in claim 4, the term is not arbitrary. This treatment of the term is inconsistent as the examiner suggests that the term is both patentable and unpatentable at the same time. Because of this inconsistent behavior, the applicants request the examiner to issue an action containing a proper, consistent analysis of the term.

Second, claim 4 has contained this term since filing. Thus, the examiner has had two prior opportunities to examine and reject this term, so the applicants' amendment can not have

necessitated this rejection. As such, the applicants respectfully assert that making this action final was improper and the examiner should give the applicants an opportunity to respond to this rejection by issuing a non-final rejection containing a consistent analysis.

#### **IV. Response to § 103 rejections**

The examiner rejected claims 1-16 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,895,450 ("Sloo") in view of U.S. Patent No. 6,330,551 ("Burchetta") and further in view of U.S. Patent No. 6,236,980 ("Reese"). These rejections are respectfully traversed for the following reasons.

##### **A. Inconsistency in examiner's rejections**

In the bottom two lines of page 3 the examiner asserts "Sloo ('450) does not explicitly disclose "a request forming step which forms requesting conditions including a plurality of conditional items . . .". However, while discussing Sloo, in the last full paragraph of page 3 the examiner asserts "wherein the formation of the requesting conditions comprises . . . (column 4, lines 61-67.)"

These two statements directly contradict. First the examiner asserts that Sloo does not disclose forming requesting conditions, then the examiner seems to assert that Sloo discloses forming requesting conditions. Because of this inconsistency, the examiner fails to articulate a proper rejection and set forth a *prima facie* case of obviousness.

##### **B. Claims 1-13**

Claim 1 recites condition items that include "conditional items formed from an inquiry to the requester, conditional items automatically formed from requester information, and conditional items calculated from values of already established request conditional items". The references cited by the examiner do not teach or suggest this feature.

The examiner admits that Sloo does not teach this feature. In the last two lines of page 3, the examiner asserts "Sloo ('450) does not explicitly disclose "a request forming step which forms requesting condition including a plurality of conditional items . . .". As Sloo does not teach forming requesting conditions including conditional items, then Sloo also must not teach forming conditional items in the particular manners recited in this claim.

Burchetta also does not teach this feature. First, it is noted that the examiner fails to point to any portion of Burchetta that describes this feature. Further, Burchetta teaches accepting from a user three dollar amounts (col. 4, ll. 48-54), then using these dollar amounts to negotiate with a second user. Nowhere does Burchetta teach generating from these dollar amounts any further items. As such, Burchetta does not teach or suggest conditional items

formed "from an inquiry to the requester", "from requester information", or "from values of already established request conditional items".

Reese is directed to a method of recommending securities. As such, nothing in Reese is comparable to "conditional items formed from an inquiry to the requester, conditional items automatically formed from requester information, and conditional items calculated from values of already established request conditional items".

As neither Sloo, Burchetta, or Reese teach anything comparable to "conditional items formed from an inquiry to the requester, conditional items automatically formed from requester information, and conditional items calculated from values of already established request conditional items", no combination of these patents disclose this feature as well. As such, these patents do not render claim 1 unpatentable.

Claims 3, 12, and 13 contain a feature similar to the feature of claim 1 discussed above. As a result, the prior art cited by the examiner does not render these claim unpatentable as well. Claims 4-11 are not unpatentable over the cited prior art at least because they depend from an allowable base claim.

### **C. Claims 14-16**

Claim 14 recites a method with multiple "responders" that bid against each other. For example, line 4 recites "responders", line 8 recites "another response information with a cheaper bid price", and line 11 recites "a bid price of a competitor". None of the prior art cited by the examiner discloses anything comparable to these features.

Regarding Sloo, on page 6 of the Office action, the examiner admits that Sloo does not teach this feature. However the examiner then asserts that Burchetta describes this feature.

Burchetta describes a system for resolving a dispute between parties (see column 3, lines 46-53). The system includes two parties: claimants and defendants. The claimants input dollar amounts into the system, and the defendants input dollar amounts into the system (col. 3, ll. 54-62). In response, the system performs calculations to determine if a settlement occurs (col. 4, ll. 48-64).

Nothing in Burchetta is comparable to multiple "responders" that bid against each other. In Burchetta, each side collectively submits dollar values. As all the parties that make up a side act in unison, there is no "competition" between the parties. Therefore, no parties "bid" against each other.

In the Office action, the examiner argues that "multiple offers are analogous to "bid price of a competitor"". As explained, all of these offers are presented by a single side, either the

complainant side or the defendant side. Because all parties making up a side act in unison, there is no bidding and thus, no "competition". If the examiner continues to present this argument, the applicants respectfully request the examiner to point out which parties the examiner feels constitute the multiple "competitors" that bid against each other.

Furthermore, as explained in the prior reply, Burchett teaches away from these features. The system of Burchetta has security features that prevent third parties from participating in the negotiation process. These features prevent any parties from presenting competing bids.

Nothing has been cited or found in Reese that suggests modifying Sloo or Burchetta to overcome the deficiencies discussed above. Therefore, claim 14 is patentable over any combination of Sloo, Burchetta, or Reese. Regarding claims 15 and 16, the prior art cited by the examiner does not render these claims unpatentable at least because these claims contain features similar to the features of claim 14 discussed above.

## **V. Conclusion**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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